

Scr. No. 10/021,899  
Response to Office Action of 2 October 2004  
Atty Docket 117163-34

## REMARKS

### Restriction Requirement

The Examiner has indicated that the application contains two distinct inventions, with Invention I (comprising claims 11-15 and 30-36) being directed to a stent and Invention II (comprising claims 1-10 and 16-29) being directed to a method for producing a stent with certain characteristics.

The Examiner has also indicated that Invention I is taught in five patentably distinct species, namely as shown in Figs. 4A, 4B, 4C, 4D and 5. The Examiner has indicated that claim 11 is presently generic. Applicant does not traverse the determination that the species are patentably distinct.

Applicant traverses the Examiner's determination that Inventions I and II are properly restricted from each other, but ratifies the decision to have the claims of Invention II examined, as made by a telephone conversation with the applicant's representative on 15 April 2003.

Accordingly, applicant elects Invention II. Since Invention I is not elected, no election of species is required at this time.

Since claims 11-15 and 30-36 are not elected, applicant has cancelled them, reserving the right to file a divisional application.

### Claim status

Claims 1-36 were pending in this application at the time of the Office Action. Of these, claims 1-10 and 16-29 have been elected above and claims 11-15 and 30-36 are cancelled as being drawn to a non-elected invention.

New dependent claims 37 through 43 are introduced, as described below, in response to the Examiner's claim objections.

New independent claim 44 is introduced as an independent version of claim 9, as explained below, with claim 9 being cancelled.

New independent claim 45 is also introduced, as described in more detail below.

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### **Claim objections**

The Examiner's comment about claim 1 and the unpaired closing bracket is noted. Accordingly, claim 1 as presented above reflects the claim as understood by the applicant, which is the same as it is understood by the Examiner.

The Examiner's comments regarding claims 4, 6, 16 and 21-24 are noted and they are amended to incorporate the Examiner's suggestion. New claims 37-43 are introduced to specifically recite the "in particular" embodiment previously in the claims. As seven dependent claims are introduced in this manner but more than seven dependent claims are cancelled above as result of the restriction requirement, there is a net reduction in the number of claims.

The Examiner's comments regarding terms such as "flowable", "pourable", "sinterable" and "cold-setting" have been considered. The Examiner is reminded that this case originated in Germany and the case is filed as a translation from the original German language version. In reviewing the matter with the client, it is clear that the invention here involves the steps of placing a granular solid material or material mix into an opening on a stent and acting on the granular solid material or material mix in the opening to consolidate it as a mass that will be retained in the opening as a marker element. Exemplary language in the specification which supports this, as now claimed at new independent claim 45, is found at paragraphs [0034] through [0036].

In further support of new claim 45, the applicant directs the Examiner's attention to claim 1 as originally filed in German. The German word that was initially translated as "hardened" is "verfestigt," which is believed to be more properly translated as "consolidated." Similarly, the term "verfestigbares" in the original claim 1 is more properly "able to be consolidated" rather than "hardenable." Accordingly, this term is now rendered as "granular" in English, since the solid granular material is consolidated into a larger piece in the process of the present invention. No new matter is introduced in introducing this claim 45.

### **Claim rejections**

The Examiner has made rejections of claims 1, 2, 4-6, 10, 17, 19, 21 and 23 as anticipated by US Pat No 5,632,771 to Boatman ("Boatman '771"). Boatman '771 teaches placing a piece of what is effectively a wire of a radiopaque material into an opening and melting it to fuse it into

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place. See Col. 7, lines 51-53. Unlike claim 45, Boatman '771 does not teach placing a granular material into the opening and consolidating it in situ to form the marker element.

The Examiner has rejected claims 1, 2 and 4 as being anticipated by Berry (WO99/15108). As the Examiner states, Berry teaches melting gold or other material into an eyelid. Berry does not anticipate claim 45, as it does not teach placement of a granular solid material or material mix, since molten material is not "a granular solid material or material mix."

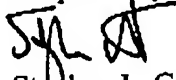
The Examiner has rejected claims 1-2, 4-6, 10, 17, 19, 21, 23 and 29 as being anticipated by Globerman (WO97/33534). As understood by the applicants, Globerman teaches placement of an individual marker element into an opening and pressing it or deforming it to form a mechanical connection with the stent, as stated at paragraph [0006] in the present invention. As such, it does not anticipate claim 45, as it does not teach placement of a granular solid material or material mix, since a singular marker element is not "a granular solid material or material mix."

In the obviousness rejections of the Examiner, there is a citation to US Pat. No. 6,379,381 to Hossainy ("Hossainy '381"), which the Examiner characterizes as teaching adding a marker material, dissolved in a solvent, into an opening and evaporating the solvent. This is not a teaching of placing a granular solid material or material mix into the opening and consolidating the granular solid material or material mix to form a marker element, as required by claim 45.

**Allowable subject matter**

The Examiner has noted that claim 9 would be allowable if in independent form, as the prior art fails to disclose a hardening step effected by galvanic deposit. New claim 44 is an independent claim that is equivalent to claim 9, so it should be allowable. New claim 45 should also be allowable, for the reasons set out above.

Respectfully submitted,



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